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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,462	11/07/2001	John A. Ewen	31223-81316	2085

7590 04/09/2004

David J. Alexander
Fina Technology, Inc.
P. O. Box 674412
Houston, TX 77267-4412

EXAMINER

CHOI, LING SIU

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,462

Applicant(s)

EWEN, JOHN A.

Examiner

Ling-Siu Choi

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1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 37-78 is/are pending in the application.
- 4a) Of the above claim(s) 67-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 37-55 and 62-66 is/are allowed.
- 6) ☐ Claim(s) 56-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Amendment filed January 9, 2004. Claims 1-36 were canceled and claims 37-78 are now pending, wherein claims 37-66 are drawn to a polymer product prepared in the presence of a catalyst system and claims 67-78 are drawn to the catalyst system. Claim rejection under 35 USC 112 is removed and rejection of claims 56-61 under 35 USC 102(e) as being anticipated by Kaminsky et al. (US 4,769,510) is maintained.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

**A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

3. Claims 56-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaminsky et al. (US 4,769,510).

The rejection is adequately set forth in paragraph 7 of Paper No. 8 and is incorporated herein by reference.

Response to the Amendment

4. Applicant's Amendment filed January 9, 2004 have been fully considered but they are not persuasive.

Applicant: "In any case, Kaminsky fails to disclose an indenyl group which is substituted with at least one hydrocarbonyl radical as set forth in applicant's independent claim 56. In this respect, **the reference to substituted groups in Kaminsky is with reference to cyclopentadienyl groups and not indenyl groups**. This is further reinforced by the examples in Kaminsky and the Kaminsky claims, which are directed to ethylene bis(4,5,6,7-tetrahydro**indenyl**)zirconium dichloride."

Examiner: it is noted that indenyl represented by $C_9R'_m$ could include tetrahydroindenyl because the formula do not include number of hydrogens. Furthermore, the present claims are drawn to the product-by-process claims. "The claim is unpatentable even though the prior product was made by a different process" (emphasis added). *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964,966 (Fed. Cir. 1985). And, the polymer disclosed by Kaminsky et al. is isotactic. Thus, the rejection of the present claims is maintained.

Allowable Subject Matter

5. This application contains allowable subject matter (claims 37-55 and 62-66) because the prior art of record [US 4,769,510 to Kaminsky et al. and US 4,522,982 to

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Ewen], either alone or in combination, fails to teach or suggest the polymer product prepared in the presence of a catalyst comprising a silicon hydrocarbyl radical as the interannular bridge, the use of the silicon hydrocarbyl radical as the interannular bridge resulting in a high intrinsic viscosity and T_m compared with the use of hydrocarbyl radical as the interannular bridge. If the non-elected claims are canceled and the hereinabove rejections under 35 USC 102(e) are obviated, the application could be passed to issue.

Conclusion

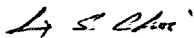
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.



Ling -Siu Choi

April 4, 2004